

REMARKS

Claims 9-17 are currently pending in the present application, wherein Applicants propose to amend claims 9 and 15-17 to more clearly define the present invention. Applicants respectfully submit that independent claims 9 and 15-17 and dependent claims 10-14 stand in condition for allowance. No claims have been added or canceled as a result of this response.

I. Claim Rejections Under 35 U.S.C. § 101

The Office Action rejects claims 9-17 under 35 U.S.C. § 101, because the claimed invention is directed to non-statutory subject matter. This rejection is respectfully traversed.

Claims 9-15 and 17

Under 35 U.S.C. § 101 the apparatus as recited in claims 9-15 and 17 is statutory as the claims are directed to an actual physical apparatus. The claimed apparatus is a machine, which is statutory subject matter. One may not interpret the claimed apparatus to be directed entirely to software or a data structure for the mere fact that an apparatus can comprise an element that includes software.

Applicants respectfully submit that claims 9-15 and 17 should be in condition for allowance. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 9-15 and 17 under 35 U.S.C. § 101.

Claim 16

With regard to claim 16, the Office Action rejects claim 16 for not falling within one of the four statutory categories of invention. The Examiner's assertion that the "instant claim neither transforms underlying subject matter nor positively ties to another statutory category that accomplishes the claimed method steps, and therefore does not qualify as a statutory process" is unfounded. Claim 16 recites a transformation of the supplied image signal into an output image signal. The supplied image signal and the output signal represent a physical image or article that can be reproduced. Therefore, the method as recited in claim 16, transforms the "underlying subject matter (such as an article or material) to a different state or thing" (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J.

Love, titled "Clarification of 'Processes' under 35 U.S.C. § 101). Applicants respectfully submit that claim 16 should be in condition for allowance. Accordingly, Applicants respectfully request the withdrawal of the rejection of claim 16 under 35 U.S.C. § 101.

II. Claim Rejections Under 35 U.S.C. § 112

The Office Action rejects claims 9-14 and 17 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

If one skilled in the art would be able to identify the structure, material or articles from the description in the specification for performing the recited function, then the requirements of 35 U.S.C. § 112, second paragraph, are satisfied. Specifically, one skilled in the art would understand what circuitry is necessary to implement the means recited in the claims. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 9-14 and 17 under 35 U.S.C. § 112, second paragraph.

With regard to claim 9, the Examiner asserts that the claim language is unclear and can be interpreted as disclosing that the "process for converting image data" could be performing the determination of those points, which are impossible to be interpolated. The Examiner's interpretation is unfounded because the claim recites that characteristic points "are determined to be impossible to be interpolated by a process for converting image data *which is to be performed*" (claim 9). Since the process for converting image data has yet to be performed when the look up table was made, the Examiner's interpretation of the claim is incorrect.

Accordingly, Applicants respectfully request the withdrawal of the rejection of claim 9 under 35 U.S.C. § 112.

III. Claim Rejections Under U.S.C. § 103

Claims 9-16

The Office Action rejects claims 9-16 under 35 U.S.C. § 103(a) as being unpatentable over Bhattacharjya (U.S. Patent No. 5,809,213), hereinafter the '213 patent in view of Horikawa (U.S. Patent No. 5,744,130) hereinafter the '130 patent. This rejection is respectfully traversed.

In response to Applicants' arguments of August 20, 2008, the Examiner agrees that data points may be wholly discounted by the '130 patent. The Examiner also asserts that there is nothing in the claims that all characteristic points must be accounted for. Although Applicants disagree with the Examiner's assertion, to further prosecution claims 9 and 15-16 have been amended.

The '213 patent and the '130 patent fail to teach or suggest color characteristic data that includes a lookup table which is "composed of all characteristic points which are points indicating the relationship between supplied image data and output image data which are determined to be impossible to be interpolated" by a process for converting image data which is to be performed (claims 9 and 15-17).

For at least the reasons above with respect to claim 9, claims 15-16 are similarly allowable. Therefore, Applicants respectfully assert that the combination of the '213 patent with the '130 patent is flawed for at least the basis that both the '213 and the '130 patent fail to render Applicants' claimed invention obvious for failing to meet the burden under a *prima facie* case under § 103. The '213 patent in view of the '130 patent fails to teach or suggest each and every claimed element. Therefore, Applicants respectfully request the withdrawal of the rejection of claims 9-16 under § 103 over the '213 patent in view of the '130 patent.

Therefore, Applicants respectfully submit that dependent claims 10-14 are allowable for at least the same reasons as provided for independent claims 9 and 15-16, as well as for the additional limitations recited therein.

Claim 17

The Office Action rejects claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Bhattacharjya in view of Horikawa and further in view of the PNG Specification (<http://www.w3.org/TR/REC-png-961001>). This rejection is respectfully traversed.

The PNG Specification does not remedy the noted deficiencies of Bhattacharjya in view of Horikawa and is only relied upon to teach dependent claim features. This reliance on the PNG Specification fails to make up for the deficiencies of Bhattacharjya in view of Horikawa discussed above with respect to independent claims 9 and 15-16. Therefore, the asserted

combination of Bhattacharjya in view of Horikawa and further in view of the PNG Specification (assuming these references may be combined, which Applicants do not admit) fails to establish *prima facie* obviousness of any pending claim.

Similar to the analysis provided above with respect to claims 9 and 15-16, the '213 patent and the '130 patent fail to teach or suggest color characteristic data that includes "a lookup table which is composed of all characteristic points which are points indicating the relationship between supplied image data and output image data which are determined to be impossible to be interpolated" by a process for converting image data which is to be performed (claims 9 and 17).

Accordingly, for at least these reasons, claim 17 is clearly distinguishable over Bhattacharjya in view of Horikawa in further view of the PNG Specification. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

IV. Conclusion

All matters having been addressed in view of the foregoing, Applicants respectfully request the entry of this Amendment, the Examiner's reconsideration of this application, and the immediate allowance of all pending claims.

Applicants' undersigned representative remains ready to assist the Examiner in any way to facilitate and expedite the prosecution of this matter. If any point remains an issue in which the Examiner feels would be best resolved through a personal or telephone interview, please contact the undersigned at the telephone number listed below

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

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Respectfully submitted,

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